Amendment and Communication in response to Office Action, Paper 3 at p. 7]. Stated

another way, as commonly explained in the field of computer technology:

> Real time refers to the ability of the computer system to respond to input
>
> immediately.

(See www.webopedia.com/TERM/r/real time.html). This commonly accepted definition

of "real time" has now been added to the specification. As explained herein this

definition of "real time" is supported by the original specification.

As supported in the specification of the present application, an object of

Applicant's invention is to provide a World Wide Web interface for the care provider, so

as to provide such information on a *real time basis*. [See Application at page 2, ll. 5-6].

In one embodiment of the present invention, the inputted performed procedure data is

accessed *in real time*. [See Application at page 4, ll. 17-18]. Likewise, the method of the

present invention can include providing updated participant eligibility data *in real time*.

[See Application at page 4, ll. 18-20].

The eligibility and utilization data are updated so that accurate data is provided *in*

*real time*. [See Application at page 5, ll. 7-8]. More specifically, the updating means

operates on a 24-hour basis and permits *continuous* updating of the data stored in the

system. [See Application at page 11, ll. 20-21]. As a result, throughout the operation of

the system, the operator is provided with accurate, dependable information pertaining to a

subscriber on a *real-time* basis. [See Application at page 11, ll. 21-23]. Since this

information is *continuously updated,* the information received by the system operator at

the dental care provider comprises *accurate and up to the minute information*. [See

Application at page 12 ll. 4-6]. Thus, the invention places this information, *in real time,*

which has previously been available to the dental care provider only through a telephone call with the carrier, *at the immediate computer access of the operator,* as long as the operator has access to the World Wide Web and the appropriate login information. [See Application at page 12 ll. 6-9]. Hence, among other things, Applicant's invention provides dental care providers with (1) *up to the minute responses* to eligibility and/or utilization inquiries (2) *immediately,* i.e. in *real time.*

Nevertheless, in the Office Action, Paper No. 7, the Examiner concluded as follows:

> . . . this definition of real time, *requiring instantaneous response to queries* is not how the term "real time" was defined in the disclosure. The term "real time" is repeatedly used in the disclosure to express the concept that *the physician accessible data is constantly updated, so that when it is accessed, it provides accurate (i.e. real time) information.* (Emphasis Added). [Office Action, Paper No. 7 at p. 3, Par. 3].

> \*                    \*                    \*

> Thus, *the term "real time" has nothing to do with an instantaneous response to a query,* but is related to the preparation of accurate, updated data.

> This concept of *providing accurate, updated data* is exactly what is disclosed by Spurgeon. (Emphasis Added). [Office Action, Paper No. 7 at p. 4, Pars. 2-3].

Based on these premises, the Examiner then concluded that:

> The Spurgeon reference states that:

> *Push Technology ensures that the data on the provider interface is always kept up*

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*to date, because the data is pushed out to the provider interface computer into a*

*provider database located therein, rather than requiring the provider to pull the*

*data down from the information exchange server.* (Emphasis in Original).

This statement matches the qualifications for accurate (i.e. real time) data which is

described in applicant's disclosure. Accordingly, Examiner does not find that

Spurgeon lacks the teaching of "real time" as suggested by applicant. [Office

Action, Paper No. 7 at p. 4, Pars. 3 -5].

However, the concepts of (1) *instantaneous responses to inquiries* and (2)

*providing accurate information* are two *separate* concepts related to providing

information in "real time" – *both* of which are: provided by Applicant's invention;

supported by the disclosure of the present Application; and, *not* both provided by

<u>Spurgeon</u>. Simply because information is accurate and up to the minute does *not* mean

that it is provided in "real time" – if the necessary instantaneousness or immediacy of

response is lacking. For example, even the most up to date information is not provided in

*"real time"* if the user has to place a phone call and wait for the response or the

equivalent of a call back from a server. Conversely, just because information is provided

in "real time" (i.e., virtually instantaneously) does not necessarily mean it is up-to-date

information.

Applicant's disclosure recognizes this dichotomy between (1) *instantaneous*

*responses* and (2) *providing accurate responses*. In particular, the Application states:

In sum, through the use of the above-described system, the participating dental

care provider is given an apparatus and a method for determining the eligibility of

subscribers . . . determining the overall success in operation of design of the plan,

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and determining the participant's benefits including patient co-payments. . . . In addition, since the information is *continuously updated,* the information received by the system operator at the dental care provider comprises [1] *accurate and up to the minute information.* Thus, the invention places this information, *in real time,* which has been previously available to the dental care provider only through a telephone call with the carrier, [2] *at the immediate computer access of the operator,* as long as the operator has access to the World Wide Web and the appropriate login information. (Emphasis Added). [Application at p. 12, ll. 7-9].

Hence, rather than limiting "real time" to providing only [1] *accurate and up to the minute information* as contended by the Examiner, the Application actually equates "real time" with [2] namely, providing such updated information *at the immediate computer access of the operator.* The "push technology" system of <u>Spurgeon</u> simply cannot do so. While it may repeatedly update its information and "push" such information to an interface with its subscribers, a user accessing such information at its computer terminal is not going to necessarily get an instantaneous response of updated information – because the user will be dependant on the system of <u>Spurgeon</u> to update and push such information out to the subscriber at its regularly scheduled intervals. Accordingly, while <u>Spurgeon</u> may *update* its information, it does not allow a subscriber to necessarily receive or access such information *at the immediate computer access of the operator.* Hence, as defined in the Application, <u>Spurgeon</u> does not operate in "real time".

The Claims as amended further emphasize the differences of Applicant's invention over the prior art. In particular, Claim 1 of the present invention as amended, includes a system for determining eligibility of a participant with respect to particular

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procedures necessitated by that participant, by a dental care provider for determining plan

design comprising at least one computer having at least one data storage means, at least

one input means, and at least one output means, with participant data stored on the data

storage means pertaining to a participant; means associated with the computer for

determining eligibility of the participant *in real time*; means associated with the computer

for inputting a particular procedure necessitated by a participant in order to determine

eligibility for the procedure *prior* to providing the procedure; and means associated with

the computer for recording utilization of benefits by the dental provider *in real time*.

Claim 13 as amended includes a system for a method of providing information to

dental care providers regarding a participant comprising the steps of: determining

eligibility of the participant comprising the steps of: inputting an identifier data pertaining

to at least one participant as input; searching for the identifier data in the participant data

of a storage means; providing output in the form of data provided *in real time* pertaining

to the eligibility of the participant; inputting a procedure code *in real time* to determine

whether the code is covered by the participant's plan *prior to performing the procedure*;

and recording the utilization of benefits and claims *in real time* by way of a procedure by

the dental care provider comprising the steps of: inputting an identifier data pertaining to

the participant as input; and, inputting a performed procedure data.

Claim 19 as amended claims a method for establishing a network for the

administration of coverage to a dental care provider comprising the steps of: providing a

plurality of computers; linking the computers to form a network; storing data pertaining

to a participant and to a coverage plan pertaining to the participant; and providing access

to the data of the participant from at least one of the computers, to in turn, facilitate at

least one of: determining *in real time* the eligibility of the participant for a particular procedure prior to performing the procedure; and recording the utilization of participant benefits by the dental care provider *in real time* to form utilization records.

Likewise, multiple dental carriers from client 95 or from server 90 and others who require the utilization records can likewise log in to the system and obtain utilization records pertaining to the subscribers. [See Application at page 11 ll. 5-7]. Access can be restricted to only subscribers or tailored to meet the differing needs of members of the system. [See Application at page 8, l. 7; page 9 ll. 3-8]. Spurgeon '129 does not provide for *multiple* dental care providers to automatically access the participant data for a particular participant. As stated in Spurgeon '129:

> For instance, an existing subscriber may choose to change primary care providers in which case a deactivation message is broadcast to the old provider and subscriber insurance data is broadcast to the new provider. Also, when an insurer credentials new providers, the new provider is typically assigned a batch of previously unassigned subscribers. The subscriber insurance data for all of the subscribers is broadcast out to the newly-credentialed provider.
>
> [*See* Spurgeon '129 at Col. 8 ll. 44-57].

Accordingly, if a subscriber is not *assigned* to a provider in the Spurgeon '129 system, the subscriber insurance data must be broadcast to that provider before it can be accessed, despite the fact that the subscriber is a member of the plan. In Applicant's claimed system, *multiple* providers can access the participant data of a particular participant, without the need to *assign* the participant to a provider or to *broadcast* that information to the assigned provider. Hence, Spurgeon '129 fails to teach or suggest,

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among other things, the capability of Applicant's claimed system to provide participant data regarding participants that are not assigned to the dental care provider by the plan, so as to enable *multiple* dental care providers to directly access participant data for a participant – as claimed in new Claims 26 and 27. As a result, those claims should be deemed allowable as well.

The system of Applicant's invention provides for inputting a particular procedure necessitated by a participant in order to determine eligibility for said procedure *prior to providing the procedure.* [Application at p. 9 ll. 10-11; ll. 20-21]. Spurgeon '129 and Moore '759 do not teach or suggest that capability. [Office Action, Paper No. 3 at p. 9; Moore '759, Col. 5 ll. 14-19].

As the Examiner has previously acknowledged, Spurgeon, US Patent No. 5,890,129 further "does not teach that the eligibility determining means comprises means for inputting a particular procedure necessitated by a participant." [*See* Office Action, Paper No. 3 at page 9]. Likewise, Moore, et al., US Patent No. 5,930,759 discusses that "[u]pon receipt of this electronic claim form, clearinghouse 12 processes that claim or transaction and sends it on to the patient's insurance company or other health care payor to determine various claims of information such as eligibility, policy benefits, claim dates, a payment amount and the names of the payor and payee." [Moore '759 at Col. 5 ll. 14-19]. However, Moore, et al. '759 does not teach or suggest inputting a particular procedure necessitated by a participant in order to determine eligibility for said procedure prior to providing the procedure.

Hence, in light of these and other differences, Spurgeon '129 and Moore, et al. '759, either alone or together, if such combination were possible, fail to teach or suggest,

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among other things, the capability of Applicant's claimed system to input a particular

procedure necessitated by a participant in order to determine eligibility for said procedure

*prior* to providing the procedure, as claimed in amended Claims 1, 4, 13 and 19.
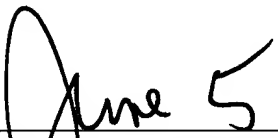
Inasmuch as: Claims 2-12 and 27 depend from Claim 1; Claims 15-18 depend from

Claim 13; and, Claims 21-26 depend from Claim 19, and serve to further limit same, they

should likewise be deemed allowable.

Applicant submits that in view of the above-identified amendments and

supporting remarks, the claims in their present amended form are patentably distinct over

the cited prior art. Preliminary Amendment and allowance of the claims, as amended, is

respectfully requested.

## REQUEST FOR INTERVIEW

In light of the foregoing, Applicant respectfully requests the opportunity to meet

and discuss the foregoing and other grounds for patentability, in person with the

Examiner. Please indicate when such a meeting could be scheduled at the earliest

opportunity, at the convenience of the Examiner.

Should anything further be required, the Examining Attorney is respectfully

requested to telephone the undersigned at (312) 551-8300.

_____ , 2002
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Respectfully submitted,

By_____
    Max Shaftal
    Registration No. 31,422

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## IN THE SPECIFICATION

Means 50 for updating the system as shown in Fig. 2, is a segment of the system which is accessed by administrators of the system through a client 95 or directly through server 90. The updating means provides the capability to update information pertaining to the identification of the subscribers, the identifications of the carriers, the identification of the effective date of coverage, the term of coverage and the level of coverage for any subscriber. This information may be updated by a specific administrator of the system. In addition, it is likewise contemplated that the system may be updated by individual carriers or plans who are given access to the updating means. For example, it is contemplated that each carrier can access [to] the updating means of the system, and can transmit to the system any changes in information pertaining to their participants as soon as such charges are implemented by the carrier. Thus, the updating means operates on a 24 hour basis, and permits continuous updating of the data stored in the system. As a result, throughout the operation of the system, the operator is provided with accurate, dependable information pertaining to a subscriber on a real-time basis. Real time, as used herein, refers to the ability of the system to respond to input immediately.

## IN THE CLAIMS

1. (Amended) A system for determining eligibility of a participant with respect to particular procedures necessitated by a participant by a dental care provider for determining plan design comprising:

- at least one computer, each such at least one computer having at least one data storage means, at least one input means, and at least one output means, the at least

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one computer having participant data stored on the data storage means pertaining to a participant;

- means associated with the at least one computer for determining eligibility of the

participant in real time; [and] *INPUT ALREADY RECITED — CONFUSING*

- means associated with the at least one computer for inputting a particular *LOC. 3 LINES 40-15*

procedure necessitated by a participant in order to determine eligibility for said

procedure prior to providing said procedure; and

- means associated with the at least one computer for recording utilization of

benefits by the dental provider in real time.


4. (Amended) The system of Claim 1 wherein the eligibility determining means

comprises:

- means for inputting a participant identifier;

- means for inputting a particular procedure necessitated by a participant;

- means for searching the participant data stored in the at least one data storage

means for the participant identifier; and

- means for providing the participant stored data pertaining to the participant

identifier to the output means of the at least one computer, to in turn, provide data as to

the eligibility of a participant for a particular procedure prior to providing said procedure.


13. (Amended) A method of providing information to dental care providers regarding a

participant comprising the steps of:

- determining eligibility of the participant comprising the steps of :

o inputting an identifier data pertaining to at least one participant as input;

o searching for the identifier data in said participant data of a storage means;

- providing output in the form of data provided in real time pertaining to the eligibility of the at least one participant;

- inputting a procedure code in real time to determine whether the code is covered by the participant's plan prior to performing the procedure; and

- recording the utilization of benefits and claims in real time by way of a procedure by the dental care provider comprising the steps of:

- inputting an identifier data pertaining to at least one participant as input; and,

- inputting a performed procedure data.


19. (Amended) A method for establishing a network for the administration of coverage to a dental care provider comprising the steps of:

- providing a plurality of computers;

- linking the computers to form a network;

- storing data pertaining to a participant and to a coverage plan pertaining to the participant; and

- providing access to the data of the participant from at least one of the plurality of computers, to in turn, facilitate at least one of:

o determining in real time the eligibility of the participant for a

particular procedure prior to performing the procedure; and

       o   recording the utilization of participant benefits by the dental care

provider in real time to form utilization records.

*REDUNDANT*

26. (New) The method of claim 19 wherein said step of providing access to participant

data includes providing access to participant data, so as to enable said participant data for

a particular participant to be directly accessed by multiple dental care providers.

*REDUNDANT*

27. (New). The system of Claim 1 wherein said participant data includes data

regarding participants so as to enable multiple dental care providers to directly access

participant data for a participant.

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IN THE

# UNITED STATES
# PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| **IN RE APPLICATION OF:** | HOROWITZ ET AL. | |
| **CASE:** | 2097-24 | |
| **PATENT NO.:** | 09/288,757 | |
| **FILING DATE:** | 4/8/1999 | |
| **FOR:** | DENTAL INSURANCE ELIGIBILIITY DETERMIANTION AND UTILIZATION RECORDATION SYSTEM | |

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Dated: June 5, 2002

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